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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/789,837

02/26/2004

Brian Acton

50269-0566

8227

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7590

05/01/2009

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EXAMINER

DUNHAM, JASON B

ART UNIT

PAPER NUMBER

3625

MAIL DATE

DELIVERY MODE

05/01/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/789,837	<b>Applicant(s)</b> ACTON ET AL.	
	<b>Examiner</b> JASON B. DUNHAM	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 47-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 47-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant amended claims 1, 3, 6-7, 18, 20, 47, 52-53, 64, 66, and 69 in the response filed December 29, 2008 in reply to the office action dated September 30, 2008. Claims 1-23 and 47-69 are pending. Applicant's arguments regarding the previous 35 USC 112, first paragraph rejection are persuasive and the rejection has been vacated.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Referring to claims 47-69. Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Claims 47-69 fail to recite a computer program that is embodied on a statutory computer-readable medium. Applicant's specification paragraphs 96-97 disclose computer readable mediums as non-statutory carrier waves.

***Allowable Subject Matter***

Applicant's remarks regarding the rejection of claim 10 in view of the prior art of record are persuasive and the previous 35 USC 103 rejection has been vacated. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Furthermore, medium claim 56 reciting similar limitations would be allowable if embodied on a statutory computer readable medium. The examiner suggests removal of carrier waves and signals from applicant's specification to overcome the above noted 35 USC 101 rejection.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-9, 11-23, 47-55, and 57-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey (US 2002/0062258) in view of Musgrove (US 7,082,426) and further in view of Talib (US 2001/0044758).**

Referring to claim 1. Bailey discloses a method for associating data with product abstractions comprising the steps of:

Maintaining a repository of previously generated product abstractions (Bailey: abstract disclosing attributes associated with items in a category being provided);

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Maintaining data that identifies a plurality of pre-established product categories (Bailey: abstract);

Bailey discloses the above but does not explicitly disclose inspecting data sets not currently matched to a product abstraction and assigning product to categories.

Musgrove discloses a method for associating data with product abstractions including:

Inspecting a first data set that includes data that corresponds to an offer to sell a particular product by a particular party, wherein the first data set is not currently matched to any product abstraction and the particular product is not currently assigned to any product category (Musgrove: figure 6 disclosing creating a new product record including assigning to a category (column 14, line 47 – column 15, line 62) for a new product for sale); and

Based on the first data set, determining whether the particular product matches any of said pre-established product categories (Musgrove: abstract, column 24, lines 27-53, and column 35, lines 4-8). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have to modified the method of Bailey to have included assigning products to categories, as taught by Musgrove, in order to create product specifications based on the determined product attributes and determined category (Musgrove: abstract).

The combination of Bailey and Musgrove discloses the above but does not explicitly disclose creating new categories based on whether similar uncategorized products have been encountered. Talib discloses a method for associating data with product abstractions including:

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In response to determining that the particular product does not match any of said pre-established product categories, determining whether to create a new product category based, at least in part, on whether similar uncategorized products have been previously encountered (Talib: abstract and paragraph 202 disclosing adding new categories to current hierarchical category taxonomies if a suitable one does not exist);

Responsive to determining that a new product category should be created, creating the new product category, storing data that indicates that said particular product belongs to said new product category, and establishing the new product category as one of said pre-established product categories (paragraph 202). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the combination of Bailey and Musgrove to have included creating new categories based on whether similar uncategorized products have been encountered, as taught by Talib, in order to products in their correct categories (paragraph 202).

The combination of Bailey, Musgrove, and Talib further discloses:

Matching said first data set with a product abstraction from said repository of previously generated product abstractions based, at least in part, on the pre-established product category to which said particular product corresponds (Bailey: abstract and paragraph 38).

Wherein the product abstraction is an electronic representation of a product and wherein the method is performed by a computer programmed to be a special purpose

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machine pursuant to instructions from program software (Bailey: paragraph 38). The examiner notes that applicant's specification defines a product abstraction as a record in a database describing a product. The product attributes of Bailey discloses record describing a product.

Referring to claim 2. The combination of Bailey, Musgrove, and Talib further discloses a method wherein said offer to sell a particular product by a particular party is a first product offering of a plurality of product offerings and said product abstraction is one of plurality of product abstractions and each product abstraction is associated with one or more product categories comprising the steps of:

Generating mapping information associating each product offering in said plurality of product offerings with one or more product abstractions in the plurality of product abstracts (Bailey: paragraphs 3 and 38);

Receiving a query (Bailey: paragraph 3); and

Generating a result set for the query based on said mapping information (Bailey: paragraph 3).

Referring to claim 3. The combination of Bailey, Musgrove, and Talib discloses a method as referenced above in the rejection of claims 1 and 2 and further discloses a method comprising the steps of:

Charging a party associated with a particular referenced entity in the result set based at least in part on inclusion of said particular referenced entity in said result set (Talib: paragraph 102 disclosing basing advertising on specific categories); and

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Determining how much to charge the party based, at least in part, on a product category associated with said referenced entity (Talib: paragraph 102 disclosing basing advertising on specific categories). The examiner notes that the motivation to combine Bailey, Musgrove, and Talib would be the same as noted above in the rejection of claim 1.

Referring to claim 4. The combination of Bailey, Musgrove, and Talib further discloses a method wherein the result set is a list of one or more references (Bailey: paragraph 3).

Referring to claim 5. The combination of Bailey, Musgrove, and Talib further discloses a method wherein each reference of the list of references corresponds to a referenced entity, and wherein each referenced entity associated with each reference in the list of references is one of a product abstraction (Bailey: paragraph 3).

Referring to claim 6. The combination of Bailey, Musgrove, and Talib further discloses a method wherein the step of matching said first data set with a product abstraction comprises the steps of:

Determining that said first data set does not correspond to any product abstractions in the repository of previously generated product abstractions that are associated with the said corresponding product category (Bailey: paragraphs 38-39);

Generating a new product abstraction based on said first data set (Bailey: paragraph 38-39); and

Matching said first data set with said new product abstraction (Bailey: paragraphs 38-39).



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Referring to claim 7. The combination of Bailey, Musgrove, and Talib further discloses a method wherein the step of creating the new product category further comprises the steps of:

Generating the new product category based on said first data set and said similar uncategorized products (Talib: figure 15 and paragraph 202); and

Associating said first data set with said new product category (Talib: figure 15 and paragraph 202). The examiner notes that the motivation to combine Bailey, Musgrove, and Talib would be the same as noted above in the rejection of claim 1.

Referring to claim 8. The combination of Bailey, Musgrove, and Talib further discloses a method wherein said result set includes a particular reference to a particular referenced entity, and wherein the method comprises the steps of:

Providing said one or more result sets to one or more users (Bailey: paragraph 3); and

Monitoring the number of times that said one or more users select said particular reference associated with said particular referenced entity from said one or more result sets (Bailey: paragraph 44).

Referring to claim 9. The combination of Bailey, Musgrove, and Talib further discloses a method comprising the step of charging a party associated with said particular referenced entity a fee based on the number of times said one or more users select said particular reference (Bailey: paragraph 139).

Referring to claim 11. The combination of Bailey, Musgrove, and Talib further discloses a method wherein the step of generating a result set comprises generating a

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page that contains one or more attributes of one or more products in one or more particular product categories (Bailey: figure 9a).

Referring to claim 12. The combination of Bailey, Musgrove, and Talib further discloses a method wherein the step of generating a result set comprises generating a page which contains a comparison of one or more attributes of one or more entities that are referenced in the page with one or more attributes of one or more other entities that are referenced in the page (Bailey: figure 9a).

Referring to claim 13. The combination of Bailey, Musgrove, and Talib further discloses a method comprising the step of providing to a party associated with said particular referenced entity, activity reports based on information generated during the step of monitoring the number of times said one or more users selects the reference associated with said particular referenced entity (Bailey: paragraph 139).

Referring to claim 14. The combination of Bailey, Musgrove, and Talib further discloses a method wherein said list of references comprises a plurality of references, and wherein the method comprises the steps of:

Displaying said plurality of references in a particular order within said result set (Bailey: figure 9a);

Determining said particular order based on a set of aspects of each reference in said plurality of references and a set of aspects of each referenced entity to which each reference in said plurality of references refers, wherein the aspects comprise one or more likelihood that a reference satisfies a query, existence of sponsorship, and cost of sponsorship (Bailey: figure 9a and paragraph 95).

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Referring to claim 15. The combination of Bailey, Musgrove, and Talib further discloses a method wherein the step of generating a result set comprises the steps of:

Applying a similar measure between one or more aspects of a particular reference and one or more aspects of a plurality of other references, wherein said aspects include one or more aspects of the reference and one or more aspects of the referenced entity (Bailey: paragraph 76); and

Selecting which references to include in said result set based on said similarity measure (Bailey: paragraph 76).

Referring to claim 16. The combination of Bailey, Musgrove, and Talib further discloses a method wherein the step of matching said first data set with a product abstraction comprises the step of comparing an identifier corresponding to said product abstraction to an identifier corresponding to said first data set (Bailey: paragraph 31).

Referring to claim 17. The combination of Bailey, Musgrove, and Talib further discloses a method wherein the identifier is chosen from the group consisting of UPC, ISBN, manufacturer, manufacturer's part number, and model number (Bailey: paragraph 31).

Referring to claim 18. The combination of Bailey, Musgrove, and Talib further discloses a method wherein the step of based on the first data set, determining whether the particular product matches any of said pre-established product categories comprises the step of comparing an identifier corresponding to one or more of said pre-established product categories to an identifier corresponding to said first data set (Talib: figure 15 and paragraph 202 disclosing comparing key words). The examiner notes that

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the motivation to combine Bailey, Musgrove, and Talib would be the same as noted above in the rejection of claim 1.

Referring to claim 19. Claim 19 is rejected under the same rationale set forth above in the rejection of claim 17 containing similar limitations

Referring to claim 20. The combination of Bailey, Musgrove, and Talib further discloses a method wherein each product category maps to one or more product abstractions, merchants, product offerings, and other product categories (Bailey: paragraph 38).

Referring to claim 21. The combination of Bailey, Musgrove, and Talib further discloses a method comprising the step of obtaining product information for said first set of data by extracting the product information from an electronic catalog (Bailey: paragraph 3).

Referring to claim 22. The combination of Bailey, Musgrove, and Talib further discloses a method comprising the step of obtaining product information for said first set of data by crawling web sites over the Internet (Bailey: paragraph 37).

Referring to claim 23. The combination of Bailey, Musgrove, and Talib discloses a method as referenced above in the rejection of claims 1 and 2 and further discloses a method wherein said offer to sell a particular product by a particular party is a first product offering of a plurality of product offerings; said product abstraction is one of a plurality of product abstractions and each product abstraction is associated with one or more product categories; and the method comprising the steps of:

Generating mapping information associating each product offering in said plurality of product offerings with one more product abstractions in the plurality of product abstractions (Bailey: paragraphs 3 & 38);

Revising said mapping information, wherein the step of revising comprises one or more of the following steps: changing a data set (Bailey: paragraph 38).

Referring to claims 47-55, and 57-69. Medium claims 47-55, and 57-69 are rejected under the same rationale set forth above in the rejection of method claims 1-9 and 11-23 containing similar limitations. The combination of Bailey, Musgrove, and Talib discloses machine readable storage mediums to perform the steps noted in the rejected method claims above (see at least paragraph 29 of Bailey).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-2, 4-7, 9, 11-14, 16-23, 47-48, 50-53, 55, 57-60, and 62-69 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments, filed December 29, 2008, with respect to the rejection(s) of claims 3 and 49 in view of Bailey and Musgrove have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Talib.

Applicant's arguments with respect to claims 10 and 56 have been fully considered and are persuasive. Please see the section above regarding allowable subject matter.

Applicant's arguments with respect to claims 8 and 54 have been fully considered but they are not persuasive. Applicant argues that the combination of Bailey, Musgrove, and Talib does not disclose monitoring the number of times a user selects a particular reference from a result set. The examiner disagrees. Paragraph 44 of Bailey discloses comparing multiple manufacturers' items, choosing those that best fit the user's goals, and compiling them into a catalog. By compiling selections into a catalog, the user has selected the reference (i.e. item) at least once from the result set.

Applicant's arguments with respect to claims 15 and 61 have been fully considered but they are not persuasive. Applicant argues that the combination of Bailey, Musgrove, and Talib does not disclose selecting references to include in a result set based on a similarity measure. The examiner disagrees. Paragraph 76 of Bailey discloses associating items (i.e. have similar features) that have been machined or tooled in a specific category (tooling).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON B. DUNHAM whose telephone number is (571)272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason Dunham/ 4/22/09